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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUEI CHANG, SUMAN KUMARLNALA, and
SENTHIL KUMAR PANDURANGAN

Appeal 2007-3785
Application 09/629,492
Technology Center 2100

Decided: March 28, 2008

Before JAMES D. THOMAS, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

COURTENAY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1, 2, 4-7, 9-11, 13-19, 20, and 21. Claims 3, 8, and 12 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

THE INVENTION

The disclosed invention relates generally to the field of Internet navigation including various communication and connection technologies and pertains more particularly to methods and apparatus, including software, for providing automated functionality to a Web-browser (Spec. 1).

Independent claim 10 is illustrative:

10. A method for performing an automated navigation sequence on a data network comprising the steps of:
 - (a) providing a machine-readable set of instructions, by a software-control application for initiating, running, and closing the navigation sequence from a server on the data network;
 - (b) executing an instance of a browser application, the execution resulting from receipt of the machine-readable set of instructions;
 - (c) executing and completing a series of tasks during the navigation sequence, including navigation, registration with a user name and password, form filling, data searching, parsing Web pages and data capture and return, according to the order of instruction contained in the machine-readable set of instructions; and
 - (d) terminating the instance of browser application, the termination resulting from the completion of the machine-readable set of instructions by the instance of browser application.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejection:

Burson
Thompson

US 6,405,245 B1
US 6,571,253 B1

June 11, 2002
May 27, 2003

THE REJECTIONS

1. Claims 1, 2, 4-7, 9-11, 13-19 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Burson.
2. Claim 20 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Burson in view of Thompson.

PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants’ Brief to show error in the proffered *prima facie* case. “After evidence or argument is submitted by the applicant in response, patentability

is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

Independent Claims 1 and 10

We consider the Examiner’s rejection of claims 1 and 10 as being unpatentable over Burson. Since Appellants’ arguments have treated these claims as a single group which stand or fall together, we select independent claim 10 as the representative claim for this rejection because it is the broadest claim in this group. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2006).

After reviewing the record before us, we address arguments presented in the Brief only to the extent that Appellants’ arguments are directed to claimed subject matter. Patentability is based upon the claims. “It is the claims that measure the invention.” *SRI Int’l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*). “Moreover, limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

Appellants argue, *inter alia*, that the browser and instances of the browser as claimed are not “controlled” in Burson (App. Br. 8-9).

In response, we find nothing in the language of representative claim 10 that positively recites who or what controls the browser or instances of the browser. We decline to read these argued limitations into the claim. While we need not consider the more narrow limitations recited in claim 1 to decide the appeal with respect to this group, we nevertheless find that “a

control application for . . . monitoring behavior of the browser instance during a navigation sequence” (claim 1) is reasonably taught and/or suggested by Burson’s site monitor 370 (*see* Burson, col. 15, ll. 53-61, Fig. 3). It is our view that such monitoring is consistent with the Examiner’s finding that the PI engine (shown in Fig. 3 as element 240) generates a simulated web client (browser instance) to perform tasks which are monitored (*see* Ans. 7). We note that Burson’s site monitor 370 is shown as an integral part of PI engine 240, as shown in Figure 3. See also Burson’s discussion of using a “simulated Web client” to supply access data needed for performing a registration procedure in an automated fashion (col. 7, ll. 34-37).

Regarding Appellants’ argument directed to an “external browser used for navigation by the user” that is controlled by APIs, we note that an “external browser” is not recited in claim 1 or claim 10 (*see* App. Br. 9, ¶1). Furthermore, an “API” (Application Programming Interface) is not recited in representative claim 10. While claim 1 does recite “a set of APIs for integrating the functional programs to the browser application,” we find Appellants have failed to persuasively rebut the Examiner’s finding that it would have been obvious at the time of the invention for an artisan to use a browser in conjunction with separate processing components that are accessed using APIs, such as the Java APIs the Examiner contends are notoriously well known in the art (*see* Ans. 12). We note that Burson expressly teaches the use of the Java Virtual Machine (col. 8, l. 2). We agree with the Examiner that APIs are notoriously well known in the art. We also note that a person of ordinary skill in the art is presumed to possess

creativity.¹ Moreover, Burson expressly teaches the use of APIs for accessing personal information data (col. 13, l. 65). Therefore, we find no evidentiary support for Appellants' contention that the Examiner has relied upon impermissible hindsight in formulating the rejection (*See* App. Br. 9).

Appellants contend that the instant claimed "browser" is not equivalent to Burson's web client (App. Br. 9). To the contrary, we find that Burson's discussion of using a "simulated Web client" (i.e., browser) to supply access data needed for performing a registration procedure in an automated fashion reasonably teaches and/or suggests Appellants' claimed navigation sequence that includes a registration step or action (Burson, col. 7, ll. 34-37) (*see* instant claim 1 and 10).

Appellants further contend that Burson fails to teach or suggest searching and parsing for data and/or images, as claimed, because the information held in the PI store points directly to the desired information or a trial and error method is used (App. Br. 9) (Burson col. 6, ll. 35-65; col. 7, ll. 40-57).

In response, we agree with the Examiner that the teachings of the Burson reference render the claimed invention obvious (*see* Ans. 13-14). We find the claimed searching and parsing of web pages is at least suggested by Burson. In particular, we note that Burson expressly teaches that "[t]he data associated with the personal information provider may include a navigation script for *guiding the application to the personal information.*" (col. 3, ll. 25-27, *emphasis added*).

¹ Courts should "take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 127 S. Ct. at 1741.

For at least the aforementioned reasons, we conclude Appellants have not shown that the Examiner erred in establishing prima facie obviousness in rejecting representative claim 10. Therefore, we sustain the Examiner's rejection of claim 10 as being unpatentable over Burson. Pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii), we have decided the appeal with respect to claim 1 in this group on the basis of the selected representative claim alone. Therefore, we sustain the Examiner's rejection of independent claim 1 as being unpatentable over Burson for the same reasons discussed *supra* with respect to representative claim 10.

Claim 13

We consider next the Examiner's rejection of dependent claim 13 as being unpatentable over Burson. Appellants contend that Burson fails to teach the claimed monitoring (App. Br. 10). To the contrary, we find Burson's site monitor 370 teaches and/or suggests machine readable instructions that provide for monitoring the navigation sequence by the software-control application, as claimed (Burson, col. 15, ll. 53-61, Fig. 3). It is our view that such monitoring is consistent with the Examiner's finding that the PI engine (shown in Fig. 3 as element 240) generates a simulated web client (browser instance) to perform tasks which are monitored, as discussed *supra* (see Ans. 7). Therefore, we conclude Appellants have not shown error in the Examiner's prima facie case of obviousness. Accordingly, we sustain the Examiner's rejection of claim 13 as being unpatentable over the teachings of Burson.

Claims 14-16

We consider next the Examiner's rejection of dependent claims 14-16 as being unpatentable over Burson.

After considering the record before us, it is our view that Appellants have failed to comply with the requirements of 37 C.F.R. § 1.111(b) by merely reciting the language of claims 14-16 and asserting that such language is not taught by the Burson reference. Moreover, a statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 C.F.R. § 41.37(c)(1)(vii). Therefore, we conclude Appellants have not shown error in the Examiner's prima facie case of obviousness. Accordingly, we sustain the Examiner's rejection of claims 14-16 as being unpatentable over the teachings of Burson.

Claims 17 and 18

We consider next the Examiner's rejection of dependent claims 17 and 18 as being unpatentable over Burson. Appellants rely on arguments previously made, contending that Burson does not teach "integrating API function modules with a browser application" (App. Br. 10).

As discussed *supra*, we agree with the Examiner that APIs are notoriously well known in the art. We note that Burson expressly teaches the use of a browser (col. 4, l. 46). Burson also teaches the use of APIs for accessing personal information data (col. 13, l. 65). After considering the totality of the evidence before us, we find that an artisan having ordinary skill and creativity would have reasonably been led to integrate API function modules with a browser in the manner claimed. Thus, we agree with the Examiner that the teachings of the Burson reference render the claimed

invention obvious.² Because we conclude that Appellants have not shown the Examiner erred, we sustain the Examiner's rejection of claims 17 and 18 as being unpatentable over the teachings of Burson.

Claim 19

We consider next the Examiner's rejection of dependent claim 19 as being unpatentable over Burson.

Appellants contend that Burson's cookies "fail to teach or suggest Web page data parsing, image search, failure-detection and dialog intercept, as claimed" (App. Br. 10).

In response, we find Appellants have not responded to the thrust of the Examiner's rejection by explaining why Burson's cookies do not teach the limitations claimed. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 C.F.R. § 41.37(c)(1)(vii). Therefore, we conclude Appellants have not shown error in the Examiner's prima facie case of obviousness. Accordingly, we sustain the Examiner's rejection of claim 19 as being unpatentable over the teachings of Burson.

Claim 21

² Our reviewing court has determined that the test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be resolved as a whole would have suggested to those of ordinary skill in the art. *In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006) (*citing In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000)). *See also* Note 1 *supra*.

We consider next the Examiner's rejection of dependent claim 21 as being unpatentable over Burson

Appellants contend that Burson does not teach or suggest generating any input data, as required to retrieve a user's personal data (App. Br. 10).

We disagree. We find that Burson expressly teaches "where the simulated Web client automatically *generates* a list of required data and a list of steps in the access process," as pointed out by the Examiner on page 15 of the Answer (*see* Burson col. 6, ll. 42-44, emphasis added). Therefore, we conclude Appellants have not shown error in the Examiner's prima facie case of obviousness. Accordingly, we sustain the Examiner's rejection of claim 21 as being unpatentable over the teachings of Burson.

Claims 2, 4-7, 9, and 11

We note that dependent claims 2, 4-7, 9, and 11 were not separately argued in the Brief. Therefore, we sustain the Examiner's rejection of these claims as being unpatentable over Burson for the same reasons discussed *supra* with respect to independent claims 1 and 10. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

Claim 20

Lastly, we consider the Examiner's rejection of dependent claim 20 as being unpatentable over Burson in view of Thompson.

Appellants contend that because Burson purportedly does not teach an ability to search, as claimed, that the motivation for the combination with Thompson does not exist (App. Br. 10).

In response, we have found *supra* that searching is taught and/or suggested by Burson. Burson expressly teaches that “[t]he data associated with the personal information provider may include a navigation script for *guiding the application to the personal information*” (col. 3, ll. 25-27, emphasis added). Moreover, we find Appellants’ argument regarding the combinability of Burson and Thompson to be misplaced. In particular, Appellants have failed to argue the limitations actually recited in claim 20, and have instead argued a “searching” limitation recited in claim 18 (from which claim 20 depends). Therefore, Appellants’ argument regarding the motivation to combine is directed to a limitation (searching) that the Examiner has rejected under Burson alone.

Because we conclude that Appellants have not shown error in the Examiner’s prima facie case of obviousness, we sustain the Examiner’s rejection of claim 20 as being unpatentable over the teachings of Burson in view of Thompson.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not shown the Examiner erred in rejecting claims 1, 2, 4-7, 9-11, 13-19, 20, and 21 under 35 U.S.C. § 103(a) for obviousness.

DECISION

The decision of the Examiner rejecting claims 1, 2, 4-7, 9-11, 13-19, 20, and 21 is affirmed.

Appeal 2007-3785
Application 09/629,492

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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CENTRAL COAST PATENT AGENCY, INC
3 HANGAR WAY SUITE D
WATSONVILLE CA 95076